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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,941	05/21/2001	Ola Olofsson	TPP 31386	9543

7590

06/25/2002

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EXAMINER

TRAN A, PHI DIEU N

ART UNIT

PAPER NUMBER

3637

DATE MAILED: 06/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/806,941

Applicant(s)

OLOFSSON ET AL.

Examiner

Phi D A

Art Unit

3637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)            | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> | 6) <input type="checkbox"/> Other:  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows: Figures 1a-1c, 2a, 2b, and 2c

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

2. The claims are deemed to correspond to the species listed above in the following manner:  
Claims 1-7 to figures 1a-1c, claim 1 and 8-10 to figures 2a-2c.

The following claim(s) are generic: 1.

3. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: the decorative strip being not part of specie 1a-1c.

Art Unit: 3637

4. During a telephone conversation with Anthony Venturino on 6/14/2002 a provisional election was made with traverse to prosecute the invention of figures 1a-1c, claims 1-7.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-10 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Drawings***

6. The drawings are objected to because figure 2b does not show “ 14’ “. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

7. The disclosure is objected to because of the following informalities: page 7 line 9 “ from of rolls” is confusing. Should it be “ form of rolls”?

Page 7 second from last line “ is limited” is confusing. Should it be “ is not limited”?

Appropriate correction is required.

***Information Disclosure Statement***

8. The information disclosure statement filed 5/21/2001 to Sweden (462809), France (2697275) and France (2268922) fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

10. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the distance between that of the lips being the same as that of the grooves as measured from the center, does not reasonably provide enablement for distance of the lips being somewhat smaller than the distance of between the grooves. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

*The claims are thus examined as best understood to be claiming the distance at the distal edge of the groove to the distance of the closer edges of the lips.*

***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 1, 3, 6, 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 line 2 “as seen from above” is indefinite.

Line 9 “a floor board” is indefinite. Should it be “the respective floor board”?

Line 11 “a joining profile” is indefinite. Should it be “the joining profile”?

Claim 3 line 3 “mainly” is unclear. Is it supposed to mean “about”?

Claim 6 line 4 “joining profiles (10) exceeds the length of a floor board” is confusing. Should it be “joining profiles (10), the profile sections exceed the length of a floor board”?

Claim 7 line 3 “and/or” is indefinite. The claim must be clear to which it is “and “or “or”, not “and/or”.

14. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by

Art Unit: 3637

"such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 2 recites the broad recitation "less than half", and the claim also recites "preferably less than one quarter" which is the narrower statement of the range/limitation.

15. PRODUCT BY PROCESS CLAIM:

"The subject matter present in claim 6 is regarded as a product by process claim in which a product is introduced by the method in which it is made. It is the general practice of this office to examine the final product described regardless of the method provided by the applicant."

This applies to the rejection of claim 6 below.

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1-3, 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sweden (SU 8202375-5) in view of Pressell (4461131).

Art Unit: 3637

Sweden ( figure 1) shows a vertically joined floor board comprising floor boards (1) mainly of polygonal shape, the boards are provided with edges (2) which are provided with a groove (7), a lower side (9), a decorative top surface (surfaces are inherently decorative by nature), the floor boards are joined by means of separate joining profiles, the edges are provided with one groove (8) each, the grooves are arranged parallel to its respective edge and that the joining profiles are provided with lips (11) arranged in pairs, the lips each is intended to be received by the groove of the floor board so that the adjacent floor boards are guided and fixed horizontally by the lips, the lips are connected to each other by a middle section (at 4-4) of the joining profile, the joining profile is provided with a central cheek, the cheek having an independently resilient cheek (10), the cheek is provided with tongues (12) wherein each tongue is received by one groove (7) so that adjacent floor boards are guided in the vertical direction, the distance of the grooves on the lower side to the closest edge being less than one quarter the width of a floor board, the distance of between each groove and the closest edge is mainly the same, the distance between the lips of the joining profile being somewhat smaller than the distance between the grooves placed on each side of and closest to the edge of two adjacent floor boards.

Sweden does not show the cheek being a first and a second independently resilient cheek.

Pressell shows a joining profile having a central cheek made up of a first and a second independently resilient cheeks (68) to join floor boards together vertically.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Sweden to show the cheek being a first and a second independently resilient cheek because the examiner takes Office Notice of the equivalence of two cheek on a joining profile and one cheek on the joining profile for their use in the static structure art and the



Art Unit: 3637

selection of any of these known equivalents to join the floor boards would be within the level of ordinary skill in the art.

Per claim 7, Sweden as modified by Pressell shows all the claimed limitations except for the floor boards or the joining profiles being partially coated with glue or adhesive tape.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Sweden's modified structure to show the floor boards or the joining profiles being partially coated with glue or adhesive tape because it would enhance the secure joining of the floor boards to the joining members.

18. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sweden (SU 8202375-5) in view of Pressell (4461131) as applied to claim 2 above, and further in view of Schwartz (5058333).

Sweden as modified by Pressell shows all the claimed limitations except for the part of the floor board located between each edge and its respective groove is thinner than the maximum thickness of the floor board by means of a recess located on the lower side.

Schwartz discloses the part of the floor board located between each edge (40) and joined by a joining profile is thinner than the maximum thickness of the floor board by means of a recess located on the lower side to enable concealing the profile to allow for a smooth lower surface.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Sweden's modified structure to show the part of the floor board located between each edge and its respective groove is thinner than the maximum thickness of the floor

Art Unit: 3637

board by means of a recess located on the lower side because it would enable the concealing of the profile to allow for a smooth lower surface as taught by Schwartz.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows different floor boards with joining profiles.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 703-306-9136. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

A handwritten signature in black ink, appearing to read 'Phi Dieu Tran A', with a large circular flourish at the end.

Phi Dieu Tran A  
June 17, 2002